

REMARKS/ARGUMENTS

By this paper, Applicant replies to the Office Action of July 11, 2007 and respectfully requests reconsideration of the application.

Claims 1-17 and 22-35 are now pending, a total of 31 claims. Claims 1, 6, 9, 15, 25, 27 and 30 are independent.

All claims now pending recite language similar to (though not necessarily identical to) the following:

receiving from a user a ... selection of contestants in a plurality of the event's contests, and establishing a unified wager based on the outcome of the selected contestants, the selections available to the user include selecting contestants from a non-consecutive plurality of contests within the event

The July 2007 Office Action concedes that this language is sufficient to distinguish all references.

I. Enablement

An unnumbered paragraph at page 2 of the Office Action starts with the “enablement” form paragraph. However, the basis for the remainder of this paragraph is unclear.

A. Legal Standard for Enablement

The test for “enablement” is “undue experimentation.” *In re Wands*, 858 F.3d 731, 737, 8 USPQ2d 1400, 1404 (Fed. Cir. 1988). “Whether undue experimentation is needed is not a single, simple factual determination, but rather is a conclusion reached by weighing many factual considerations.” *Id.* The enablement requirement may be met by the knowledge in the art, even if it is not in the specification. *Falkner v. Inglis*, 448 F.3d 1357, 1365, 79 USPQ2d 1001, 1006 (Fed. Cir. 2006). “[A] patent applicant does not need to include in the specification that which is already known to and available to one of ordinary skill in the art.” *Koito Mfg. Co. v. Turn-Key Tech LLC*, 381 F.3d 1142, 1156, 72 USPQ2d 1190, 1200 (Fed. Cir. 2004).

B. Procedural Requirements for Setting Forth an Enablement Issue

MPEP § 706.03(c), form paragraphs 7.31.02, note 3, requires that an “enablement” rejection discuss the *Wands* factors, and requires the Examiner to comply with MPEP

§§ 2164.01(a) and 2164.04. MPEP § 2164.04 reads as follows, in pertinent part (citations and quotations omitted):

2164.04 Burden on the Examiner Under the Enablement Requirement

... the minimal requirement is for the examiner to give reasons for the uncertainty of the enablement. This standard is applicable even when there is no evidence in the record of operability without undue experimentation beyond the disclosed embodiments.

[T]he analysis and conclusion of a lack of enablement are based on the [*Wands*] factors discussed in MPEP § 2164.01(a) and the evidence as a whole... The language should focus on those factors, reasons, and evidence that lead the examiner to conclude that the specification fails to teach how to make and use the claimed invention without undue experimentation, or that the scope of any enablement provided to one skilled in the art is not commensurate with the scope of protection sought by the claims.

C. The Office Action Is Procedurally Inadequate to Raise Any Enablement Issue

The Office Action observes several different embodiments that fall within the claim language. The Office Action then simply ignores all instructions in the MPEP. The Office Action never even mentions “undue experimentation.” The Office Action never mentions the *Wands* factors. The Office Action makes none of the showings and considers none of the factors that are procedurally required by MPEP § 2164.04 to bring any rejection into existence. No rejection exists.

The Office Action merely asserts that certain information is not expressly in the specification. The Office Action’s observations are irrelevant. *Falkner*, 448 F.3d at 1365, 79 USPQ2d at 1006. No rejection exists.

II. Pages 3-6

A. Legal Standard for Anticipation

There is no anticipation “unless all of the same elements are found in exactly the same situation and united in the same way ... in a single prior art reference.” *Perkin-Elmer Corp. v. Computervision Corp.*, 732 F.2d 888, 894, 221 USPQ 669, 673 (Fed. Cir. 1984). It is error to “[treat] the claims as mere catalogs of separate parts, in disregard of the part-to-part relationships

set forth in the claims...” *Lindemann Maschinenfabrik GmbH v. American Hoist and Derrick Co.*, 730 F.2d 1452, 1459, 221 USPQ 481, 486 (Fed. Cir. 1984).

B. Procedural Requirements for Setting Forth an Anticipation Issue

MPEP § 2131 explains an Office Action’s duties under § 102:

2131 Anticipation — Application of 35 U.S.C. 102(a), (b), and (e)

TO ANTICIPATE A CLAIM, THE REFERENCE MUST TEACH EVERY ELEMENT OF THE CLAIM

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. The identical invention must be shown in as complete detail as is contained in the ... claim.

It is the Examiner’s burden to make all required showings on all limitations of a claim, including the interrelationships within the claim. *Ex parte Berg*, 2002 WL 32346092 at *2, <http://des.uspto.gov/Foia/ReterivePdf?system=BPAI&fINm=fd020456> at 4 (BPAI Feb. 6, 2003) (“the examiner must present a full and reasoned explanation of the rejection in the statement of the rejection, specifically identifying underlying facts and any supporting evidence, in order for appellants to have a meaningful opportunity to respond,” emphasis in original). It is not an applicant’s duty to guess at the Examiner’s position. *Ex parte Schricker*, 56 USPQ2d 1723, 1725 (BPAI 2000).

C. Applicant Requests a Clear and Explicit Comparison of All Claim Language to the References

This Attorney concurs with the observations of the previous attorney, that previous Office Actions have been either imprecise or incomplete. As a first example, this attorney notes that the first comparison of the claim language “allowing a player to choose the event’s races to be included in a wager” came very late in prosecution. As a second example, it appears that a first instance of “race” in the claim was compared to one thing in the references, and a second instance of “race” compared to something else, or else “horse” and “race” of the claims were compared to the same thing in the references. It’s not clear which. The Office Actions have not been sufficiently clear to communicate the Examiner’s view or make the Examiner’s position clear. Applicant suggests that completing a table such as the following may be helpful to ensure precision:

event	
race	
winner	
unified wager	
non-consecutive plurality of races ¹	
paying the player ... within the unified wager	

¹It is important that the “races” here must be the same as the “races” elsewhere in the claims, and kept distinct from the “horses” or the “event.”

Applicant respectfully requests that there be no further “piecemeal examination.”

III. Pages 9-10

The unnumbered paragraph at pages 9-10 concedes that no reference shows non-consecutive races. The Office Action then states “It would not be beyond one of routine to recognize any combination of racing events could be included in a multiple race wager as taught above.” “Not beyond one of routine” is not now and never has been an authorized test for obviousness. After an element – a unified wager based on non-consecutive races – has been conceded to be absent from the art, there can be no obviousness. If any obviousness issue is raised in the future, Applicant requests that the Examiner follow the Office’s guidance set forth in MPEP §§ 2143-2143.03.

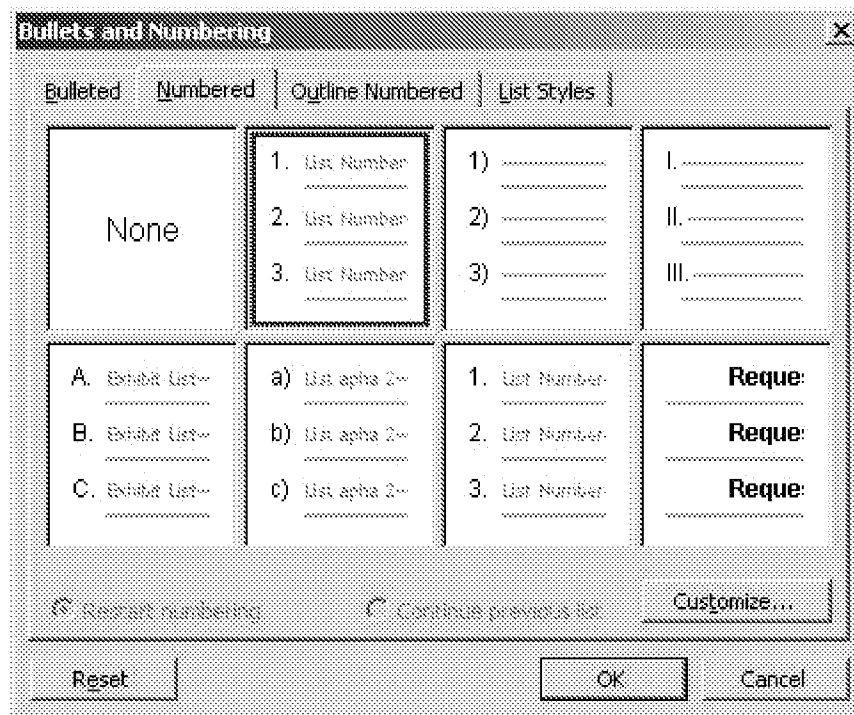
IV. Designation of Paragraphs in the Office Action

The Examiner’s attention is drawn to MPEP § 707.07(k):

707.07(k) Numbering Paragraphs

It is good practice to number the paragraphs of the Office action consecutively. This facilitates their identification in the future prosecution of the application.

The examiner’s attention is also drawn to the menu in Microsoft Word, Format > Bullets and Numbering, which gets to this dialog box:



The Examiner will observe that this Reply paper is remarkably less clear than it would have been had there been paragraph numbers in the Office Action to which to refer.

V. Withdrawal of Previous Remarks

The claims as now pending are broader in some respects than previous claims. Applicant intends that the claims as now pending be interpreted under the ordinary interpretation understood in the art. Applicant hereby rescinds, and no longer intends that the claims be limited by, any assertion, statement, argument, amendment or other action in this patent application, or any application whose file history is available for use in interpreting any patent issuing on this application, that might be taken to be a surrender or disclaimer of any subject matter from the scope of any claim. No such assertion, statement, argument, amendment or other action in this application or in any such available application should be taken as a surrender or disclaimer from, and may not be used to interpret, any claim of this patent, or any claim of any patent to which such applications' file histories may be pertinent.

Applicant hereby requests that the Examiner re-visit any previous surrender, disclaimer or characterization of claims, and re-visit any prior art that may have been avoided or intended to be avoided by such surrender, disclaimer or characterization.

VI. Conclusion

In view of the amendments and remarks, Applicant respectfully submits that the claims are in condition for allowance. Applicant requests that the application be passed to issue in due course. The Examiner is urged to telephone Applicant's undersigned counsel at the number noted below if it will advance the prosecution of this application, or with any suggestion to resolve any condition that would impede allowance. In the event that any extension of time is required, Applicant petitions for that extension of time required to make this reply timely. Kindly charge any additional fee, or credit any surplus, to Deposit Account No. 50-3938, Order No. 04-7131.

Respectfully submitted,
CANTOR INDEX L.L.C.

Dated: December 17, 2007

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